

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ulrich KLAR et al.

Examiner: LAO, Marialouisa

Serial No.: 10/563,058

Group Art Unit: 1621

Filed: January 3, 2006

Title: METHOD FOR PRODUCING C1-C15 FRAGMENTS OF EPOTHILONES AND THE DERIVATIVES THEREOF

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed on October 22, 2007, applicants elect with traverse Group I, claims 1-3 and 5, and as a species elect the compound of example 1, (the end-product, intermediate ABC = 1k). The traversal is on the basis that the PTO has not established that it would pose an undue burden to examine the full scope of the application.

In accordance with M.P.E.P. 803.02, the Examiner is reminded that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.

No fee is believed to be due with this response; however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

Csaba Henter, Reg. No. 50,908
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: Sch-2116

Date: November 27, 2007

K:\Sch\2000 to 2999\2116\Restr Reply.doc